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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,650	04/02/2004	Cheol Kim	70591.86468-001	3406

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EXAMINER
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MOSSER, KATHLEEN MICHELE

ART UNIT	PAPER NUMBER
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3715

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/817,650

Applicant(s)

KIM, CHEOL

Examiner

Kathleen Mosser

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

In response to the amendment filed 10/14/2005, claims 6, 7 and newly added claims 8-11 are pending.

### *Drawings*

1. The drawings were received on 10/14/2005. These drawings are approved.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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2. Claims 6-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stevens, III (US 5769643). Stevens teaches a radio frequency/ intermediate frequency unit (Figure 3, element 64); a modem (also part of element 64); a protocol controller (part of the processor, element 62); a coder-decoder for converting digital audio data to analog audio signals (an inherent property of the "sound circuitry", figure 3, element 65); a display (Figure 3, element 56); a memory (Figure 3, element 58); and a digital signal processor/ central processing unit (Figure 3, element 62) operable in at least two modes including a reception mode and a learning (display) mode (see col. 3 8-9), as in claim 6. The examiner notes that the "for" clauses of the claims is drawn to the intended functionality of the components claimed. It is the examiner's position that the components of the Stevens system are inherently capable of performing or perform the same functions as those intended by the claimed components, as there is nothing barring the option of the components in the manner claimed. A key unit (claim 7) is shown in Figure 2, element 18. Regarding claim 8 the display of video data associated with audio data is shown in at least col. 3: 12-19. Regarding claim 9, the "data transmitting controller for controlling a transmission route based on whether the protocol controller generates digital audio data or display caption data" is an inherent part of any computer system which is capable of producing both audio and video outputs. This function is performed within the processor to ensure that video data is sent to the video display and its associated circuitry and audio data is sent to the speakers, headphone, etc and it's associated circuitry.

Regarding method claims 10 and 11, the steps as recited are performed through the actual use of the system in the manners described. Each of the determining steps are performed inherently, when the processor receives a transmission or displays the data contained in that transmission.

Alternatively, Stevens discloses the claimed invention except for the specific arrangement and /or content of indicia (printed matter) set-forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to alter the information to be caption language learning data including audio and caption data, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the

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claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPZ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of educational material does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. the caption language learning data and the substrate e.g. the computer signals which is required for patentability.

### ***Response to Arguments***

3. Applicant's arguments, see the amendment filed 10/14/2005, with respect to claims 6-11 have been fully considered and are persuasive in view of the amendments to the claims. The rejections under 35 USC §112, 2<sup>nd</sup> paragraph and 35 USC §103(a) in view of Guy and Kirkland of claims 6 and 7 have been withdrawn.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Corder (US 5387104) teaches a learning system using audio and video data
  - b. Yalen (US 4986257) a teaching apparatus which includes both audio and video language skills information
  - c. Kirksey et al (US 5741136) teaches a learning system and method which use both audio and "caption" data
  - d. Fong et al (US 5219291)
  - e. Wakamoto (US 5810598) teaches a learning/gaming system which uses both audion and "caption" type outputs

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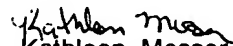
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen Mosser  
Patent Examiner  
Art Unit 3715

December 30, 2005